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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/874,450	06/05/2001	David E. Allport	ER1604.02US	6282

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DISCOVISION ASSOCIATES
INTELLECTUAL PROPERTY DEVELOPMENT
2355 MAIN STREET, SUITE 200
IRVINE, CA 92614

EXAMINER

NGUYEN, JIMMY H

ART UNIT	PAPER NUMBER
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2673

DATE MAILED: 01/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/874,450

Applicant(s)

ALLPORT, DAVID E.

Examiner

Jimmy H. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,13,14,17,27,33-35,45 and 67-70 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.

- 6) ☒ Claim(s) 1,13,14,17,27,33-35,45 and 67-70 is/are rejected.

- 7) ☐ Claim(s) _____ is/are objected to.

- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

DETAILED ACTION

Request for Continued Examination

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/24/2003 has been entered. Claims 1, 13, 14, 17, 27, 33-35, 45 and 67-70 are currently pending in the application. An action on the RCE follows:

Drawings

2. It is noted Applicant that only fig. 6 has a sufficient support found in the original disclosure, specifically page 6, last paragraph, i.e., the steps in order. Accordingly, the new proposed drawing is disapproved by the Examiner because the new matter is entered since there is no where in the original disclosure, when filed, to disclose expressly the ordered steps in figs. 7-11, e.g., there is no where in the original disclosure, when filed, to disclose expressly that step 710 in fig. 7 must be executed immediately after step 705 in fig. 7, step 810 in fig. 8 must be executed immediately after step 805 in fig. 8, and etc..

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show all features of the invention specified in the claims. Therefore, the following claimed limitations must be shown or the feature(s) canceled from the claim(s): "the previous used state of the first user comprises one of a screen last viewed, time of day or night the first user logged-on or logged-off, a content data displayed, a selection made and a navigation history used" as recited

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in claim 13, “a first set of functionality”, “a second system state” and “at least one factor”, as recited in claim 27, “a category of use” recited in claim 34, “a subject matter of activity within a category of use” recited in claim 35, “a group user state” recited in claim 45, “data representing said first user’s previous use states” and “user profile data representing said first user’s preferences” recited in claim 67, “another user profile” recited in claim 68, “said first user’s profile” and “said first user’s previous use patterns” recited in claim 69, and “the at least one factor is a present time of day or night” recited in claim 70. No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

4. The amendments to the specification filed 12/24/2003 have not been entered because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: there are no where in the original disclosure to disclose expressly **the steps in orders** and the new proposed drawing filed 07/08/2003 is disapproved by the Examiner (see above).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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6. Claims 1, 13, 14, 45, 67 and 68 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As per claims 1, 13, 14, 67 and 68, the application, when filed, does not disclose the method for accessing functionality of a consumer comprising accessing a second state of a controller, receiving bio-metric input of a first user, establishing a system state of the controller and providing access to functionality of the system state, as recited in independent claim 1. The original disclosure, specifically from page 6, line 16 through page 7, line 2, discloses a method for controlling multi-user access to functionality of consumer devices comprising supplying bio-metric input of a first user, providing access to the functionality of consumer devices, supplying bio-metric input of a second user, and providing access to the functionality of consumer devices, and specifically page 7, lines 7-13, discloses a method for controlling multi-user access to functionality of consumer devices comprising providing a first user access to a first set of functionality of consumer devices, said controller in a first state associated with the identify of the first user, and switching to a second state after being in the first state, said switching to the second state occurring at a time dependent upon at least the identity of the first user. However, the disclosure, specifically drawing, does not disclose expressly the method for accessing functionality of a consumer device comprising all the steps in the manner as recited in independent claim 1 above. Additionally to claim 67, "said step of establishing a system state of the controller comprises ... preferences", lines 1-4, is not properly described in the disclosure.

Additionally to claim 68, the step of “enabling said first user to switch to another user profile” is not properly described in the disclosure.

As per claim 45, the application does not disclose the claimed method of controlling multi-user access to functionality of a consumer device comprising all the steps in the manner as recited in independent claim 45. The disclosure, specifically from page 13, line 19 through page 14, line 10, discloses that a group user such as “USER1+USER2” use the controller. However, the disclosure does not provide any specific method as recited in claim above.

7. Claims 13, 27, 33-35, 69 and 70 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding to claim 13, the disclosure, when filed, does not contain sufficient information regarding to the claimed feature, “the previous used state of the first user comprises one of a screen last viewed, time of day or night the first user logged-on or logged-off, a content data displayed, a selection made and a navigation history used”, of claim 13, so as to enable one skilled in the pertinent art to make and use the claimed invention. The disclosure, specifically at page 12, lines 1-4, only discloses as much as recited in the claim above. However, the disclosure does not contain such drawing, description and details the state of time of day or night, the state of the first user logged-on or logged-off and etc., as recited in claim above, e.g., the state of time of day or night, the state of the first user logged-on or logged-off and etc. are shown on the display area 20, so as to enable one skilled in the pertinent art to make and use the claimed invention. See MPEP 608.01(p).

Regarding to claim 27, 28, 33-35, 69 and 70, the disclosure, when filed, does not contain sufficient information regarding to the claimed features, “switching to a second system state at a time calculated by an algorithm” which incorporates at least one factor other than the passage of a certain amount of time”, of independent claim 27, lines 8-10, “the at least one factor is a category of use associated with the consumer device” additionally recited in claim 34, “the at least one factor is a subject matter of activity within a category of use associated with the consumer device” as additionally recited in claim 35, “said identity of said first user comprises said first user’s profile and said first user’s previous use patterns” as additionally recited in claim 69, “the at least one factor is a present time of day or night” as additionally recited in claim 70. The disclosure, specifically at page 14, lines 11-23, discloses that another feature that may be incorporated into the field of controller technology is the use of time-out algorithms which incorporate factors other than merely the passage of a certain amount of time, and the time-out algorithm may incorporate factors such as the category of use, a subject matter of activity within a category of use, power down, the class of the user, the time of day or night, and etc.. However, the disclosure does not contain such description and details how the controller switches from one state to another state at a time calculated by an algorithm, i.e., how the calculated time relates with the category of use, a subject matter of activity within a category of use, power down, the class of the user, the time of day or night, and etc., and how the algorithms incorporating the category of use, a subject matter of activity within a category of use, power down, the class of the user, the time of day or night, and etc., may be incorporated in the controller.

8. Due to the rejections under 35 USC 112, first paragraph above, the following art rejections are based as best understood by the Examiner.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 13, 14, 17, 27, 33-35, 45 and 67-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Park (USPN: 5,990,803, cited in IDS filed 06/05/2001 entered as paper No. 2) in view of Merjanian (USPN: 5,920,642, cited in IDS filed 06/05/2001 entered as paper No. 2) and further in view of Applicant's Admitted Prior Art, herein after AAPA.

As per claims above, Park discloses a hand-held controller and an associated method for accessing functionality of consumer devices such as a television and other appliances, the controller (see fig. 1) comprising a fingerprint recognizer (120) (corresponding to the claimed bio-metric input component) for receiving a fingerprint pattern from a user, a display (150) (corresponding to the claimed graphical display) for displaying on the display data representing available functions to be executed, and a menu selector (110) comprising a menu key and a selection key (col. 2, lines 33-37) (corresponding to the claimed plurality of physical actuating buttons), wherein an access to the functionality of the consumer devices by the use of the controller is dependent upon the bio-metric input from the authorized user (fig 2). Park further discloses the fingerprint recognizer including a memory EPROM for storing initially fingerprint pattern of the authorized person (col. 2, lines 28-29, col. 3, lines 1-15), but Park is silent on a number of users. Accordingly, Park discloses the claimed subject matter except for accessing to

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functionality by a number of users and establishing the states of the controller when using by different users or upon log-on by a first user.

However, Merjanian discloses a related hand-held controller, wherein a first user may allow to access a first set of functionality upon an identity of the first user determined by the controller based upon input to the controller from the first user, a second user may allow to access a second set of functionality upon an identity of the second user determined by the controller based upon input to the controller from the second user and so on (col. 3, lines 27-53).

It would have been obvious to one of ordinary skill in the art to utilize the capability of multi-user access to functionality of the consumer device, as taught by Merjanian (col. 3, lines 27-53) in the hand-held controller of Park because this would allow a plurality of the users accessing to functionality of consumer device. However, the combination of Park and Merjanian does not disclose expressly establishing the states of the controller when using by different users or upon log-on by a first user, as claimed.

However, AAPA discloses that a system, which inherently comprises a controller programmed to present a user upon log-on thereto, a system state being the previous system state of the controller that was in effect at the end of a previous use of the controller by the user, is well-known to one of ordinary skill in the art (page 3, line 20 through page 4, line 7). Further, for first example, the first user previously caused the controller establishing a previous system state, e.g., a state of displaying a letter "A", then the second user accessed the controller without a need of log-on (since the first user did not log off the controller) and caused a letter "B" displayed on the display, so as to cause the controller having a system state, a state of displaying a letter "B", different than the previous system state, i.e., a state of displaying a letter "A". After

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that, the second user manually restored the first user's previous state, i.e., a state of displaying a letter "A", and locked the controller either manually or automatically, after some delay time.

When the first user logs back on to the controller, the controller establishes **a current system state, which is the same as the previous state, i.e., a state of displaying a letter "A"**.

Accordingly, AAPA discloses the claimed feature, "establishing a current system state of the controller similar to or being the previous system state" as recited in the claims. It would have been obvious at the time of the invention was made to utilize of AAPA's teachings, as discussed above, in the hand-held controller of Park in view of Merjanian, i.e., programming the controller capable of establishing a system state being the previous system state of the controller that was in effect at the end of a previous use of the controller by the user, because this would allow the user immediately logging back to the previous state at any time, thereby avoiding the unnecessary waste time.

Response to Arguments

11. Applicant's request for approving the new proposed figures 7-11, page 9, has been fully considered, but it is not persuasive because they raise the issue of new matter, see the objection above. In order to be approved, it is suggested the applicant to show where in the original disclosure, when filed, to disclose expressly all the steps of figs. 7-11 in order.

12. Applicant's argument with respect to the rejections under 35 USC 112 to claims 1, 13, 14, 45, 67 and 68, page 9, has been fully considered, but it is not persuasive because (i) "accessing the functionality of a consumer device" and "controlling multi-user access to the functionality of consumer" are just "preambles", thereby not being an issue of the rejection under 35 USC 112, first paragraph, and (ii) as discussed in the rejection above, there is no where in the

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disclosure, when filed, to disclose any method comprising all the steps as recited in the claims above.

13. Applicant's argument with respect to the rejections under 35 USC 112 to claims 13, 27, 28, 33-35, 69 and 70, page 9, has been fully considered, but it is not persuasive because the disclosure, when filed, does not contain sufficient information, such as drawing and detailed description, regarding to the claimed features in such a way to enable one skilled in the pertinent art to make and use the claimed invention.

14. Applicant's arguments with respect to the rejections under 35 USC 103(a), pages 10-11, are not persuasive because as follows:

i. With respect to the Park reference, applicant argued that the Park reference does not disclose the feature, "establishing a system state being a previous used state by the first user", page 10, examiner agrees. However, as discussed in the rejection, AAPA obviously discloses the feature, "establishing a system state being a previous used state by the first user", by virtue of the operation described on page 3, line 20 through page 4, line 7.

ii. With respect to the Merjanian reference, applicant argued that the Merjanian reference does not disclose the feature, "the state that was the previous used state by the first user the last time he/she had access to the remote control", page 10, examiner agrees. However, as discussed in the rejection, AAPA obviously discloses this feature by virtue of the operation described on page 3, line 20 through page 4, line 7.

iii. With respect to the AAPA reference, applicant argued that the AAPA reference discloses that if a second user wants his or her own preferences in the user interface, he or she would have to start from the initial screen or system state, examiner agrees. However, AAPA

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further teaches that a second user would have to start from the initial screen or system state, if the first user was properly logged off of the controller (see page 3, lines 16-19) and if the first user didn't restore the second user's last state (see page 4, lines 4-7). It is noted Applicant that the claimed invention does not limit that the first user must properly logged off of the controller and the first user can't restore the second user's last state.

For the above reasons, it is believed that the rejections under 35 USC 103(a) should be sustained.

Conclusion

15. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

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will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy H. Nguyen whose telephone number is (703) 306-5422.

The examiner can normally be reached on Monday - Thursday, 8:00 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached at (703) 305-4938.

Any response to this action should be mailed to:

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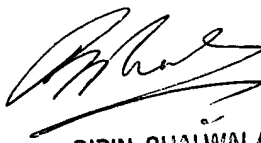
or faxed to:

(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

JHN
January 11, 2004


BIPIN SHALWALA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER